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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/698,137	10/30/2003	Andreas Arning	DE920020036US1	4938
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IBM CORP (YA) C/O YEE & ASSOCIATES PC P.O. BOX 802333 DALLAS, TX 75380			EXAMINER TIV, BACKHEAN	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/698,137

Applicant(s)

ARNING ET AL.

Examiner

Backhean Tiv

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 8/29/07.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 and 15 is/are pending in the application.
- 4a) Of the above claim(s) 14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-13 and 15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Detailed Action

Claims 1-13,15 are pending in this application. This is a response to the
Amendment/Remarks filed on 8/29/07. This action is made **FINAL**.

Priority

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which
papers have been placed of record in the file.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that
form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public
use or on sale in this country, more than one year prior to the date of application for patent in the United
States.

Claims 1, 4-13,15 are rejected under 35 U.S.C. 102(b) as being anticipated by
US Patent 6,052,709 issued to Paul.

As per claim 1, Paul teaches a computerized method for improved handling of
messages directed to an user of an electronic messaging system(col.1, lines 50-60):

determining user characteristics capable of identifying said user as addressee of
a message(col.5, lines 10-15); and

analyzing a certain message and determining its message characteristics from
one or a multitude of message fields(col.6, lines 1-15); and

applying at least one deduction rule of a potential set of deduction rules to said certain message, which assigns based on said user characteristics and said message characteristics a role of said user to said certain message said role revealing said user's relationship to said certain message(col.6, lines 1-43).

As per claim 4, the computerized method for improved handling of messages according to claim 1, wherein in a message list comprising said message and other messages directed to said user; said role assigned to said message is indicated visually(col.7, lines 1-14).

As per claim 5, the computerized method for improved handling of messages according to claim 4, wherein said indication is anyone or combination of the following: an icon uniquely indicating said role; a textual indication of said role(col.7, lines 1-14).

As per claim 6, the computerized method for improved handling of messages according to claim 4, wherein said message list is organized in groups of messages to which a same role has been assigned(col.7, lines 1-14).

As per claim 7, the computerized method for improved handling of messages according to claim 6, wherein within each of said groups messages are organized according to any prioritization technology(col.8, lines 55-65).

As per claim 8, the computerized method for improved handling of messages according to claim 1, wherein, if said message is opened, said message characteristics contributing to said assigned role are visually emphasized(col.7, lines 15-35).

As per claim 9, the computerized method for improved handling of messages according to claim 1, wherein, said third step is performed for each new arriving

message; or when a message is opened; or at repeating time intervals for messages for which no role has been assigned yet(Abstract).

As per claim 10, the computerized method for improved handling of messages according to claim 1, wherein, said user characteristics and/or message characteristics are determined by application of data/text mining technology(col.7, lines 35-55).

As per claim 11, the computerized method for improved handling of messages according to claim 1. wherein, if multiple of said deduction rules are applicable, a predefined precedence scheme defines which of said applicable deduction rules finally succeeds(col.7, lines 15-55).

As per claim 12, the computerized method for improved handling of messages according to claim 1, wherein said messaging system is an e-mail system and said messages are e-mails(Abstract).

As per claim 13, a computer system comprising means adapted for carrying out the steps of the method according to claim 1(Abstract).

As per claim 15, a computer program product stored on a computer usable medium, comprising computer readable program means for causing a computer to perform a method according to claim 1 when said program is run on said computer(Abstract).

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 6,052,709 issued to Paul.

As per claims 2,3 Paul explicitly teaches the computerized method for improved handling of messages according to claim 1, wherein said user characteristics at least comprise one of the following elements:

a user ID of said user in said messaging system; a name of said user; a nickname of said user(col.5, lines10-45); and

wherein said message characteristics at least comprise one of the following elements: the contents of a TO: field; the contents of a CC: field, identifying addressees receiving a complimentary copy; the contents of a BCC: field, identifying addressees receiving a blind carbon copy; the contents of the body of said message(col.6, lines 1-44).

Paul, however does not explicitly teach wherein said set of deduction rules comprises at least one of the following deduction rules: first deduction rule, which assigns a role of SINGLE-ADDRESSEE, if said user is the only addressee in said TO: field; second deduction rule, which assigns a role of MULTIPLE-ADDRESSEES, if said user is one of a multitude of addressees in said TO: field; third deduction rule, which assigns a role of SINGLE-CC-ADDRESSEE, if said user is the only addressee in said

CC: field; fourth deduction rule, which assigns a role of MULTIPLE-CC-ADDRESSEES, if said user is one of a multitude of addressees in said CC: field; fifth deduction rule, which assigns a role of BCC-ADDRESSEE, if said user is an addressee in said BCC: field; sixth deduction rule, which assigns a role of DISTRIBUTION-LIST, if said user is a member of a distribution list in said TO: field, seventh deduction rule, which assigns a role of DISTRIBUTION-LIST, if said user is the only or one of a multitude of addressees in said TO: field but said message does not contain a salutation with said user's name or nickname; eighth deduction rule, which assigns a role of DISTRIBUTION-LIST, if said user is the only or one of a multitude of addressees in said TO: field and if said message comprises a footer and said footer does not comprise information referring to a person or entity said user has an established relationship with; ninth deduction rule, which assigns a role of SINGLE-ADDRESSEE or a role of MULTIPLE-ADDRESSEES respectively, if said user is the only one or one of a multitude of addressees respectively in said CC: field but said message comprises a salutation with said user's name or nickname.

Paul does teach analyzing emails by checking header fields and/or the body message and if the message match data stored in the corresponding data category of the exclusion list manager, then the email is marked indicating "JUNK"(col.6, lines 26-58).

Therefore it would have been obvious to one ordinary skill in the art at the time of the invention to modify the teachings of Paul to include filtering rules to check for single or multiple address and labeling emails since Paul does teach checking header fields

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and labeling email as "JUNK" in order to reduce the amount of emails that goes to the Inbox(Fig.5).

One ordinary skill in the art at the time of the invention would have been motivated to modify the teachings of Paul to include filtering based on different types of header fields in order to improve the process of determining SPAM emails.

Response to Arguments

The applicant has cancelled claim 14 therefore the Office withdraws the 101 rejection. The applicant has amended the claims 1-13,15 to overcome the claim objection and 112 2nd paragraph rejection. Applicant's argument as per claims 1-13,15, pertaining to lack antecedent basis for "said role revealing" is persuasive. The Office withdraws those rejections.

Applicant's arguments, as per claims 1-14,15 pertaining to the art, filed 8/29/07 have been fully considered but they are not persuasive. The applicant argues in substance:

a) Paul does not teach, page 6-9, "use of deduction rules and a role of said user to said message";

b) Paul does not teach, page 7, "A computerized method for improved handling of messages directed to a user of an electronic messaging system".

In reply to a); During patent examination, the pending claims must be "given >their< broadest reasonable interpretation consistent with the specification." > In re Hyatt, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000). Although the

claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant always has the opportunity to amend the claims during prosecution, and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. *In re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969). Paul, col.2, lines 16-22, col.6, lines 1-16, Fig.3, teaches the system can filter emails using the "FROM", "TO", "BCC", "CC", and "SUBJECT" categories and/or the message body of the emails. The Office interprets these filtering rules as deduction rules.

Paul, col.8, lines 55-67, claim 1, teaches that email messages are sent to a user and are filter based on filtering data. The Office interprets that being a recipient, as opposed to a sender, of an email as "a role of said user to said message".

In rely to b); In response to applicant's arguments, the recitation "A computerized method for improved handling of messages directed to a user of an electronic messaging system" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). Furthermore, even if the Office

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were to consider the preamble, Paul's, Abstract, system teaches filtering of email messages therefore teaches "a computerized method for improving handling of messages directed to a user of an email system".

Conclusion

Examiner's Note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant.

Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in its entirety as potentially teaching of all or part of the claimed invention.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of


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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Backhean Tiv whose telephone number is (571) 272-5654. The examiner can normally be reached on M-F 6:30-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on (571) 272-3964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


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